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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/524,710 | 01/19/2005 | Katsunori Manabe | 1716299 | 1401 |

7590
Robert J Schneider
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16th Floor
111 West Monroe Street
Chicago, IL 60603-4080

01/25/2008

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| EXAMINER |
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GERRITY, STEPHEN FRANCIS

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| ART UNIT | PAPER NUMBER |
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3721

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| MAIL DATE | DELIVERY MODE |
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01/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/524,710 | Applicant(s) MANABE, KATSUNORI | |
| | Examiner Stephen F. Gerrity | Art Unit 3721 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/2/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 2 October 2007 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the Japan Patent Office official action is not translated nor is a translation available. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Drawings

2. The drawings were received on 21 November 2007. These drawings are acceptable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by applicant's admitted prior art.

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At pages 1 and 2 of the written description under the heading BACKGROUND ART and in figure 5 of the present application applicant admits that a driver structure is old and well known which has the same structural features as those set forth in claims 1 and 4. In particular, the admitted prior art discloses a driver structure comprising a blade edge (20) disposed to be in contact with a staple; a first pair of projections (21), each projection (21) of the first pair being provided at an opposite end portion of the blade edge (as seen in fig. 5); and a second pair of projections (25), each projection (25) of the second pair being provided on the blade edge (20) in vicinity of one the projections (21) of the first pair and each projection (25) of the second pair has a corner portion, and each projection (21) of the first pair has a guiding surface.

The structural limitations of the claim are met by the admitted prior art, and the recitations "and being disposed to be in contact with a corner formed between the crown and one of the leg portions for pressing the leg portion perpendicularly when the leg portion passes through the bundle of papers", "and being configured to be in contact with the crown in vicinity of one of the leg portions when the leg portion passes through the bundle of papers", "disposed adjacent to one of the corners of the staple, which engages with the crown and is configured to prevent the corner of the staple from slipping toward a central side of the crown", and "positioned at least partially outside of an outside edge of one of the leg portions, so as to guide said outside edge of the leg portion and restrict the broadening of a leading end of the leg portion when the leg portion of the staple through the bundle of papers" are functional and intended use

statements which are fully capable of being performed by the admitted prior art structure shown in fig. 5 and described at pages 1 and 2 of the present application.

Furthermore, the admitted prior art discloses a middle projection (above 24 in fig. 5) provided on the blade edge between the projections (25) of the second pair, and which is fully capable of performing the function of "to hold the crown of the staple when the pair of leg portions pass through the bundle of papers".

Regarding claim 4, the admitted prior art discloses the middle projection (above 24 in fig. 5) comprises a crown pressing portion which is fully capable of performing the function of "to press the crown".

Response to Arguments

5. Applicant's arguments filed 21 November 2007 have been fully considered but they are not persuasive. Applicant has amended the subject matter of claim 1 to include the subject matter of previous claim 3, and argued that the admitted prior art, as discussed above, does not disclose or teach a middle projection. This is not agree with by the examiner because a comparison of figure 3 showing an embodiment of applicant's claimed invention and figure 5 showing the prior art reveals that the two are virtually identical in structure, and most importantly both have identical middle projections. A review of applicant's arguments and written description describes the claimed middle projection as corresponding to crown pressing portion or third projecting part 9 in figure 1, and as crown pressing portion or third projecting part 10 in figure 2. This is what applicant has argued, but it is also noted that the claimed middle projection also corresponds to crown pressing portion or third projecting part 10 in figure 3. The

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subject matter of claim 1 and claim 4 is anticipated as the identical structure is disclosed by that which is described in the specification at pages 1 and 2 and shown in figure 5..

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Hurkmans et al. reference shows a staple driver in figure 10 of interest to applicant's disclosure.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Gerrity whose telephone number is 571-272-4460. The examiner can normally be reached on Monday - Friday from 6:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen F. Gerrity/
Primary Examiner
Art Unit 3721

18 January 2008